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REMARKS-GENERAL

All claims are rejected under 35 U.S.C. 103(a), based on combinations of Sotomayor and Meske. The rejection of claim 42 additionally cites Boguraev. The Examiner disagrees with arguments submitted by the Applicant on September 16, 2004 in response to the rejection of June 16, 2004. These arguments may be summarized as follows:

1. Combination of Sotomayor and Meske in the manner suggested by the Examiner does not result in the claimed invention.
2. Even if combination of the references arrived at the present invention, it is inappropriate to combine the cited references in the manner suggested.
 - a) No motivation to combine Sotomayor, Meske, or Boguraev is described in the O.A.
 - b) Sotomayor, Meske, and Boguraev are individually complete, and solve different problems from the present invention.
3. Sotomayor teaches away from the present invention and from combination with Meske.
4. Rejections of dependent claims are inappropriate.

The Applicant continues to respectfully disagree with the Examiner on these points. Many of the points in support of these arguments made in the previous response were not addressed in the final O.A.

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The References And Differences Of The Present Invention Thereover

Prior to discussing the claims and the above points, applicant will first discuss the references and the general novelty of the present invention and its unobviousness over the references.

Sotomayor (U.S. patent number 5,708,825) discloses a method for generating a summary page from one or more documents that are selected by an author, such that significant key topics within the documents are linked to from the summary page. Thus, the method disclosed by Sotomayor is a scheme for generating an index (to one or more documents), which may be appended to a source document. In column 5, line 53- column 7, line 10, the use of a web browser to view documents is described. However, in describing access to documents over the internet, Sotomayor states, "One problem with accessing documents over the Internet is that many documents are quite long, and thus can take quite some time to download over the network. This means that viewers are often reluctant to access a document unless they know it will be useful. The present invention facilitates dividing documents into a plurality of pages which can be efficiently chosen by a viewer and downloaded, one page at a time, and only when the particular page desired is referenced" (col 6, line 65-col. 7, line 6). Thus, the purpose of Sotomayor is to *decrease* the amount of material that a user must look at in order to find desired information. Sotomayor does not anticipate use of its indexing method in the context of a specific reader request

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for display of electronic text. According to Sotomayor, the summary page is generated prior to the reader's request for display of text. Thus, the search of the index (col. 3, line 41 – col. 4, line 8 and col. 15, line 48-67 and abstract) is completely unrelated to a reader's request for display of electronic text, and clearly does not occur after that request for display, as is required by the limitation that steps a-e of the pending application occur in sequence.

Meske (U.S. patent number 5,530,852) discloses a computer-implemented method and system for retrieving information, using as input mark-up language-containing files that describe the information to be retrieved (the first second, and third files), and which are created in response to a specific user request from within a browser (column 2, line 64-65, Fig. 4, #440, column 5, lines 60-64). The retrieved information may be presented either in brief (the fourth file) or in complete (the fifth file) form. Thus, in response to a specific user query, this system can intermittently provide links to or retrieve articles related to that query.

Boguraev (U.S. Patent Number 6,212,494) describes a method to extract linguistic information from documentation to create an online help database. A merged file is used to identify key terms that are used for searching.

The **claimed invention** is a method for using a computer system, in response to a reader's request for display of electronic text, to automatically identify and provide additional reading material related to concepts referred to within said electronic text comprising, in sequence, the steps of:

a) accessing, using the reader's computer, electronic text requested for display by the reader, said electronic text containing at least one text section;

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- b) using said at least one text section to automatically formulate, on the reader's computer, a search request related to a concept referred to in said at least one text section;
- c) responsive to said search request, automatically searching an index, wherein
 - i) said index contains a plurality of terms by which it may be searched;
 - ii) substantially all terms in said index are associated with at least one pointer to a text section; and
 - iii) at least one term in said index is associated with a plurality of pointers, at least two of said plurality of pointers pointing to different text sections;
- d) responsive to step (c), automatically identifying additional reading material related to said concept; and
- e) automatically displaying on said reader's computer display, an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text referred to in step (a).

1. Combination of Sotomayor and Meske in the manner suggested by the Examiner does not result in the claimed invention.

The O.A. (paragraph 4) asserts that:

Sotomayor discloses a method for using a computer system, in response to a reader's request for display of electronic text to automatically identify and provide additional reading material related to concepts within said electronic text comprising, in sequence, the steps of:

- a) accessing, using the reader's computer, electronic text requested for display by the reader, said electronic text containing at least one text section (col. 5, line 53 – col. 7, line 10: a viewer viewing documents uses a web browser to access the documents that a database provider may make available on the network, each document might have a plurality of pages, and each page contains a portion of a source document);
- c) automatically searching an index, wherein

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- i) said index contains a plurality of terms by which it may be searched (col. 3, line 41 – col. 4, line 8);
- ii) substantially all terms in said index are associated with at least one pointer to a text section (col. 3, line 41 – col. 4, line 8 and col. 15, lines 48-67 and Abstract); and
- iii) at least one term in said index is associated with a plurality of pointers, at least two of said plurality of pointers pointing to different text sections (col. 3, line 41 – col. 4, line 21).

As noted in the previous response, Sotomayor does not disclose these steps in sequence, nor does Sotomayor disclose step (c) in response to a request for display of electronic text. Moreover, in order to disclose step (c) of the invention, it would be necessary for the automatic index search of step (c) to be responsive to the results of an automatic formulation of a search request that was based on step (a). Thus, the Applicant respectfully disagrees with the Examiner's conclusion that Sotomayor discloses steps a) and c) of the current invention. Sotomayor does not start with the request for display of text—instead, Sotomayor starts with a library of documents and generates an index to the entire library, and then provides the index to a user who may then use that index to access one or more documents. While one of those documents may contain hyperlinks to other documents (as noted in the O.A., page 14, Sotomayor, col. 35, lines 48-57), the fact that these hyperlinks were obtained prior to request for display of the text is directly contradictory to the requirement that the index search of the invention be performed in real-time, in response to a request for display of text. While the O.A. asserts (top of page 15) that "clicking on the key-topic index term to read more information about that key-topic is considered as 'a search request related to a concept referred to in one text section'," it is clear that

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"clicking" cannot be construed as an *automatic* search, as is required by the claims of the current invention. Moreover, at the time of the "click" in Sotomayor, no index search (as in step (c) of claim 36) is performed—Sotomayor has already incorporated hyperlinks into the document that indicate where the related material is to be found.

The application is rejected based on the combination of Sotomayor with Meske, with the implication that Meske discloses steps (b), (d), or (e). In the previous response, the Applicant pointed out that Meske does not disclose steps (b), (d) or (e), an argument that the O.A. does not refute. Neither the April 16, 2004 O.A. nor the December 3, 2004 O.A. provides any explanation of where in Meske the steps (b), (d) or (e) may be found, instead asserting it would have been obvious to one of ordinary skill in the art to combine Meske with Sotomayor to perform these steps. As was pointed out in the September 16, 2004 response, Meske does not disclose step (b) (no automatic formulation of a search request is performed), step (d) (there is no automatic identification of additional reading material responsive to an index search with the limitations of step (c) of claim 36), or step (e) (there is no display of an indicator of said additional reading material, side-by-side with a portion of the electronic text referred to in step (a)).

Neither cited reference starts with a request for display of text, neither cited reference automatically formulates a search request (the search request of Meske is explicitly formulated by the user (as noted in the O.A., page 4 and page 15)), neither cited reference automatically searches an index with the limitations of step (c) of claim 36 (including the use of a search request derived from a

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document requested for display), neither cited reference identifies additional reading material related to the original text requested for display as a result of such an automatic index search, and neither cited reference displays the results of such a search side-by-side with originally requested text. Since none of the key claimed features of the current invention are disclosed by either of the cited references, it is hard to believe that one of ordinary skill in the art would have arrived at the current invention based upon a combination of these references, as is asserted by the O.A. (pages 4 and 15).

2. Even if combination of the references arrived at the present invention, it is inappropriate to combine the cited references in the manner suggested.

The O.A. makes clear that individually, none of the prior art references anticipates or renders the present invention obvious.

a) No motivation to combine Sotomayor, Meske, or Boguraev is described in the O.A.

The O.A. continues to assert that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Meske, Jr. and Sotomayor. . . . Meske Jr. provides information retrieval. . ." (O.A., pages 4-5 and 14-15). However, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to

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do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. No such suggestion or motivation is cited in either the June 16, 2004 or the current rejection, and in fact, no such suggestion or motivation exists in either reference or in the knowledge generally available to one of ordinary skill in the art at the time the application was filed.

The O.A. (pages 16-17) asserts that "because Meske discloses receipt of a plurality of information organized by profile and topic and parsing information into portions including anchors referencing each of the portions of information to allow hypertext viewing and accessing, which is similar to identifying significant key topics, concepts, and phrases in a document and creating hyperlinks between key topics [i.e., Sotomayor] it would have been obvious to one of ordinary skill in the art to combine these inventions." However, the Applicant respectfully points out that the facts that these inventions are in a similar field and that both involve hyperlinks does not by itself provide a "teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." Moreover, the fact that both provide hyperlinks as an output would seem to teach against the use of the output from one invention as the input to the other.

Because the O.A. does not explicitly state exactly how combination of Meske and Sotomayor is believed by the Examiner to arrive at the present invention, it is difficult to examine the prior art for a motivation to make this combination. However, Sotomayor, which provides an index as its primary product, presents no teaching, motivation or suggestion that this index may be

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further used as input for additional processing to find additional related material, as is apparently contemplated by the Examiner in combining Sotomayor with Meske. Likewise, Meske presents no teaching, motivation or suggestion that search terms other than those explicitly chosen by the user be used in performing its search. There is thus no basis for concluding that one of ordinary skill in the art would have been motivated to combine these references. And, as previously noted, there is nothing in either reference to suggest that their methods be used in the context of a request for document display, or to provide the output of the current invention.

In response to the argument that no motivation is provided to combine the cited references, the O.A. (on page 18) restates O.A. paragraph 36, which outlines the O.A.'s reasoning for rejection of claim 42 under Sotomayor-Meske-Boguraev, and which does not speak to motivation for any combination of references (including Sotomayor with Meske, or Sotomayor with Meske and Boguraev). While Boguraev presents a means of creating an index for a help file, there is nothing in Boguraev, Sotomayor, or Meske to suggest that this index be used in the context of a request for document display or in the context of the inventions described by Sotomayor or Meske, much less their combination. The motivation to create an index for a help file, contained in Boguraev, simply refers to the problem that Boguraev solves, and provides no indication of a need or motivation to use this index in additional ways.

Even though neither Sotomayor or Meske demonstrates the individual steps of the present invention, much less their combination, even if they did, the

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proposed combination of Sotomayor and Meske would be very strained. While the claimed invention requires steps a)-e) to occur in sequence, in the combination described in the O.A., step a) from Sotomayor would need to be combined with step b) from Meske, which would need to be combined with step c) from Sotomayor, which would need to be combined with steps d) and e) from Meske. Certainly, the O.A. points to no motivation to combine these references in this highly novel way.

Applicant respectfully requests, that if the claims are rejected on any combination of references, that the Examiner include an explanation, in accordance with MPEP 706.02, Ex parte Clapp, 27 USPQ 972 (BPAI 1985), and Ex parte Levengood, 28 USPQ2d 1300 (BPAI 1993), of a "factual basis to support his conclusion that it would have been obvious" to make the combination.

b) Sotomayor, Meske, and Boguraev are individually complete, and solve different problems from the present invention.

Because Sotomayor, Meske, and Boguraev each describe complete inventions (see above summaries), each reference further lacks motivation for any combinations with other inventions. Each reference is complete and functional in itself, so there would be no reason to use parts from, or add or substitute parts to, any reference.

Moreover, applicant's invention solves a different problem than the references, and such different problem is recited in the claims (In re Wright, 6

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USPQ2d 1959 (1988)). In particular, the present invention provides "additional reading material related to concepts referred to within said electronic text" (Claim 36) a problem clearly not addressed by any of the cited prior art. As already discussed, Sotomayor provides a means of generating an index to one or more documents, reducing the amount of material that a user must look at in order to find desired information, Meske provides a user with a means of searching articles for relevance to topics input by the user, and Boguraev solves a problem related to creation of an online help database.

Although this argument is acknowledged by the O.A., page 17, no attempt is made to refute it.

3. Sotomayor teaches away from the present invention and from combination with Meske.

As noted, Sotomayor provides a means for reducing the amount of material that a user must review in order to find desired information. Meske is a means of retrieving updated information in response to a repeated search request. Since Sotomayor is involved in decreasing the amount of information presented, it teaches away from combinations with Meske.

One object of the present invention is to provide a reader with additional reading material. Thus, the goals of Sotomayor and the present invention are also mutually exclusive, and thus, it is inappropriate to use Sotomayor in a determination of obviousness of the present invention.

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In the O.A. (top of page 19), this argument is regarded to be the same as the argument in point A (of the O.A.) which is point 1 in the current and previous response, and is thus not separately addressed. The Applicant respectfully disagrees. The fact that Sotomayor teaches away from the present invention militates strongly against combination with Meske.

4. Rejections of dependent claims are inappropriate.

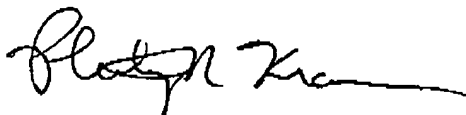
The Applicant continues to believe that rejections of dependent claims are inappropriate (as noted in the September 16, 2004 response). While the O.A. now addresses the network in claim 37 (paragraph 5), implying that Meske also contemplates the use of a network by creation of HTML files, the arguments that rejections of claims 41, 44, 45, 46, 47, 50, 52, 53, 54, 59, 60, 61, 62, and 63 are inappropriate remain unaddressed by the O.A. In any event, the rejections of all dependent claims are inappropriate for the same reasons as the rejections of independent claims 36, 68 and 69.

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Conclusion

The applicant submits that the claims are proper, definite, and define novel subject matter which is also unobvious. The applicant further submits that this application is in condition for allowance, which action he respectfully solicits.

Very Respectfully,



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I certify that on the date below, I will fax this communication and attachments, if any, to Group 2176 of the Patent and Trademark Office at the following number: 703-872-9306.

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Inventor's signature: _____

